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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,794	05/24/2001	Sakari Pernu	602.347USW1	8310

32294 7590 04/23/2004

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EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,794

Applicant(s)

PERNU ET AL.

Examiner

Marie C. Ubiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-12, 16, 18-24, 27-29 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12, 16, 18-24, 27-29 and 33 is/are rejected.
- 7) ☒ Claim(s) 12 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on February 6, 2004 has been entered. Claims 1-7, 10-12, 16, 18-24, 27-29 and 33 have been amended. Claims 8-9, 13-15, 17, 25-26, 30-32 and 34 have been cancelled. No claims have been added. Claims 1-7, 10-12, 16, 18-24, 27-29 and 33 are still pending in this application, with claims 1 and 18 being independent.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claim 16 is objected to because of the following informalities: "said requested". Claim 12 is objected because of the following informality: "in conjunction with". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. Claims 1, 3, 10-11, 18-19 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463).

As for claim 1, Gore et al. discloses a method for providing credit-checking data verification in a digital multiple-service network (*as seen on the use of a 5ESS switches, Fig. 2, elements 210 and 220*)(i.e. method for providing information in a digital multiple-

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service network); the system comprising a telecommunications network 200 (i.e. an exchange), a customer telephone 110 (i.e. a calling subscriber telecommunication terminal) connected to telecommunications network 200 via LEC 100 (i.e. first interface)(i.e. a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first interface)(See Fig. 2, elements 110 and 100 and Detailed Description, Col. 2, line 57 – Col. 3, line 2), and an ISDN terminal 310 (i.e. called subscriber telecommunication terminal) connected to telecommunications network 200 via premise switching equipment 305 (i.e. second interface)(i.e. called subscriber telecommunication terminal connected to the digital multiple-service network via a second interface); a customer places a telephone call to business 300 via telephone 110 (i.e. after a call being initiated by a calling subscriber)(See Detailed Description, Col. 4, lines 61-63); the business 300 sends a FACILITY message to 4 ESS 220 (i.e. exchange) from ISDN terminal 310 requesting credit card validation number (i.e. number of said calling subscriber) from customer on telephone 110 (i.e. requesting calling subscriber information by sending from said called subscriber telecommunication terminal to said exchange a message requesting said calling subscriber information and comprising the number of said calling subscriber, said request being initiated by said called subscriber)(See Detailed Description, Col. 4, lines 64-66 and Col. 5, lines 26-28); the FACILITY message is received at 4 ESS 200 and an SS7 TCAP message is sent, by 4 ESS 200 to a credit checking data base 280 (i.e. server), the credit checking data base 280 is connected to 4 ESS 200 via path 21 (i.e. third interface) (i.e. in response to the received message, sending a query for said

calling subscriber information from said exchange to a server implementing an information service, said server being connected to said multiple-service network via a third interface)(See *Detailed Description*, Col. 5, lines 16-26); credit checking data base 280 sends a TCAP message to 4 ESS 220 with the results of the validation (i.e. in response to the received query, sending said calling subscriber information from said server to said exchange); D-channel, Q.391, FACILITY message with the requested information is then sent, by 4 ESS 220 to business 300, the results are received at ISDN terminal 310 (i.e. in response to information, sending said calling subscriber telephone book information from said exchange to said called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call)(See *Detailed Description*, Col. 5, lines 30-43).

It can be seen that Gore et al. lacks the limitation specifying that information requested by the calling subscriber to the exchange about the called subscriber and sent from server into the exchange is that of telephone book information. It is well known in the art that a database with telephone numbers of calling subscribers can be connected to an exchange and that telephone book information can be sent from such database to a called subscriber through an exchange (as for example, Caller ID devices). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify, Gore's et al. system by further adding that requested and received information via the D-channel is that of telephone book information; thus in this

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manner the called subscriber can request the telephone book information of a calling party even if the called party is busy and/or active on the B-channel.

Claim 18 is rejected for the same reasons as claim 1.

As for claim 3, Gore et al. discloses the of information elements for transmitting between the ISDN endpoints, ISDN terminal 319 and 4 ESS 220 (i.e. wherein the calling subscriber information is transmitted in an information element comprising means for generating and sending messages in the called subscriber telecommunication terminal and in the exchange)(See *Detailed Description, Col. 5, lines 1-5*). It should be noted that while Gore et al. does not specify that information elements are use to transmit the information into the calling subscriber telecommunications terminal and the server, that the same technique can be duplicated into for these endpoints.

Claim 20 is rejected for the same reasons as claim 3.

As for claims 10-11, Gore et al. discloses that a FACILITY message is used to transmit a request from ISDN terminal 310 and 4 ESS 220, such a message is used to transmit information (i.e. wherein said message sent from said called subscriber telecommunication terminal to said exchange is a Facility message and wherein said message sent from said called subscriber telecommunication terminal to said exchange is an Information message)(See *Detailed Description, Col. 5, lines 1-9*).

Claims 27-28 are rejected for the same reasons as claims 10-11.

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As for claims 16 and 33, the Examiner takes official notice that it is well known in the art that a menu can be used to activate different features from an ISDN terminal (See for example Jrejj et al. (US 6,292,548) provided herein as reference).

5. Claims 2, 4, 19 and 21 are rejected under 35 U.S.C 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Wrede et al. (US 5,937,040).

As for claims 2 and 4, it can be seen that Gore et al. lacks the steps of transmitting the calling subscriber telephone book information in the form of a text message and by using UUS signaling.

Wrede et al. teaches a method in which a message is transmitted simultaneously as speech over a B-channel and as text file over the signaling or D-channel (See Summary of the Invention, Col. 2, lines 46-51). Wrede et al. further teaches "The conversion of the messages formats the information for the visual presentation at the display of the remote phone terminal. [...] referring to the ISDN environment, the formatting may be achieved by embedding the menu information into DISPLAY Information Elements (IEs) or into containers (i.e., envelopes) of user-to-user information compatible with D-channel transmission, so that digital character strings are sent for display in realtime at a remote ISDN display phone." (See Summary of the Invention, Col. 2, lines 44-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gore et al. method by transmitting the text file or

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service information using user-to-user signaling as taught by Wrede et al., so a user at a telecommunication terminal or remote ISDN display phone can read the service information from the terminal's display screen.

Claims 19 and 21 are rejected for the same reasons as claims 2 and 4.

6. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al (US. 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (Draft prETS 300 716: February 1996).

As for claim 5, it can be seen that Gore et al. lacks the step of transmitting the calling subscriber telephone book information using USBS signaling.

ETSI teaches "The USBS provides the unrestricted transfer (without alteration) of user information, on the D-channel of user access, in a packetized manner over a virtual circuit between reference points via the basic and primary rate access." (See Scope, page 7, lines 13-15).

It is well known in the art that in a virtual circuit, when a user wishes to transmit information, he or she simply transmit the information (as no conventional dialing is needed), thus no setup and no disconnect operations are needed when data or service information is sent. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by transmitting the user or service information using USBS signaling as taught by the ETSI draft paper, providing the user the ability to transfer the aforementioned service information over a virtual

circuit and therefore making possible for the information to be transferred to the telecommunications terminal in a rapid and cost-effective manner.

Claim 22 is rejected for the same reasons as claim 5.

7. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (ETS 300 050: October 1991).

As for claim 6, it can be seen that Gore et al. lacks the step of the server distinguishing the telephone book information service to be provided via multiple subscriber numbering (MSN) and a number of terminal-specific identification numbers have been defined for the basic subscriber interface.

ETSI teaches "The Multiple Subscriber Number (MSN) supplementary service provides the possibility for assigning multiple numbers to a single public or private access. This allows e.g.: 1) a calling user to select, via the public network, one or multiple distinct terminals out of a multiple choice; 2) to identify the terminal to the network for the application of other supplementary services." (See Scope, page 7, lines 14-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via MSN as taught by the ETSI paper, so that the service information (or other supplementary services) requested by said terminal arrives to the

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terminal where the request is originated from (this reads on "to identify the terminal to the network for the application of other supplementary services").

Claim 23 is rejected for the same reasons as claim 6.

8. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Newton (Newton's Telecom Dictionary, March 1998).

As for claim 7, it can be seen that Gore et al. lacks the step of the server distinguishing the telephone book information service to be provided via subaddressing.

Newton teaches "[subaddressing] a name for an ISDN service which enables many different type of terminals [...] to be connected to the ISDN user interface and uniquely identified during a call request." (See Newton's Telecom Dictionary, March 1998, page 683).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via subaddressing as taught by Newton, so that the service information (or other supplementary services) requested by said terminal arrives to the terminal where the request is originated from (this reads on "[terminal] uniquely identified during a call request").

Claim 24 is rejected for the same reasons as claim 7.

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9. Claims 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Masuda (4,709,387).

As for claim 12, it can be seen that Gore lacks the step of storing the calling subscriber telephone book information received by the called subscriber telecommunication terminal in said called subscriber telecommunication terminal.

Masuda teaches "A telephone having a memory for storing telephone numbers and proper names related to each telephone number, and input means for introducing said telephone numbers and proper names into said memory, an improvement in said input comprising: keyboard means including a plurality of keys consisting only of numeric keys and function keys; display means for displaying information input by said keys; said memory having stored therein alphabetic character data capable of generating all characters of an alphabet from which said proper names shall be formed..." (See Claim 1, lines 28-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the aforementioned method by providing a telecommunications terminal with capabilities for storing telephone numbers or telephone book information within memory of said terminal, therefore the user will not have to request the exchange/server to provide service information related to telephone book information that is used constantly-used by said user and that this information is readily access by said user.

Claim 29 is rejected for the same reasons as claim 12.

Response to Arguments

10. Applicant's arguments filed on February 6, 2004 have been fully considered but they are not persuasive.

11. Regarding the Examiner's rejection of claims 1 and 18 under 35 U.S.C. 103(a) as unpatentable Gore et al. Gore et al. (US 5,313,463), the applicant argues that Gore et al. fails to teach or suggest the features of the claimed invention, specifically the service process being initiated by a called subscriber and that Gore et al. is directed to the process of credit checking in an ISDN environment.

12. In response to applicant's argument that Gore et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gore et al. makes use of the D-channel (or "channel reserved for signaling") to provide the business with a customer's validation (or "number") number via an ISDN terminal 310 (or "called subscriber telecommunications terminal"), the service is initiated by the called subscriber as shown by Gore et al. in Detailed Description, Col. 4, lines 64-66 (as read on "Business 300 then sends a D-channel, Q.391, FACILITY Message to 4 Ees 220 from ISDN terminal 310"). While Gore. Et al. does not directly mention the use of the following service to check telephone book information, it would have been obvious to one of ordinary skill in the art to replace the information on the database 250 with that of telephone number of the calling subscriber.

13. Applicant's arguments with respect to the combination of Gore et al. in view of Boivie, directed to claims 10-11 and 27-28, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Clark et al. (US 5,490,251) teaches in the presently preferred embodiment, such a "user-user information element" contains non-conventional data to be utilized by the calling and/or called stations. Such stations employ application programs which utilize the data within the "user-user "information element". Such data is transmitted over the D channel of the ISDN. Accordingly, there is no need to establish communication over the B channel since the non-conventional data which would have conventionally been transmitted over the B channel may be transmitted over the D channel as part of the information element of the "user-user information element." (See Detailed Description of the Drawings, Col. 9, lines 56-67).

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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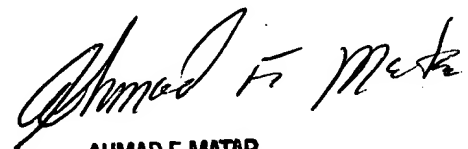
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marie C. Ubiles
April 9, 2004.


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700